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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204861
Party	Defendant Jean Pierre Biane
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Attachments	Applicant's Motion for Partial Judgment on the Pleadings_ANDALE.pdf(126569 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RED BULL GMBH,)	
)	Opposition No.: 91-204,861
Opposer,)	Serial No. 79/108,168
)	Mark: ANDALE! ENERGY DRINK
)	(& Design)
v.)	
)	Opposition Nos.: 91-210,860, 91-204,861
JEAN PIERRE BIANE, and)	Serial Nos. 85/646,316, 85/334,836
ANDALE ENERGY DRINK CO., LLC)	Marks:
)	ANDALE! & Design (Ser. No. 85/646,316)
)	ANDALE! ENERGY DRINK & Design
Applicants.)	(Ser. No. 85/334,836)
)	

APPLICANT'S MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS

Applicant Andale Energy Drink Co., LLC ("Applicant") hereby moves for partial judgment dismissing the instant opposition against application serial nos. 85/646,316 and 85/334,836 pursuant to Rule 12(c) of the Federal Rules of Civil Procedure on the ground that, as a matter of law, the marks ANDALE! (& Design) are not confusingly similar in appearance, sound, meaning, or commercial impression to the mark of Reg. No. 2829269 pleaded by Opposer, Red Bull GmbH ("Opposer"). Further, because the marks are completely dissimilar, Opposer's additional claims for false suggestion of a connection under Section 2(a) fail as a matter of law and should be dismissed with prejudice as to Ser. Nos. 85/646,316 and 85/334,836.

Statement of Facts

Applicant seeks to register the following two marks:

ANDALE! (& Design) for "Non-alcoholic beverages, namely, energy drinks, energy shots, sports drinks, soft drinks, and bottled water" in Class 32, Serial No. 85/646,316 (hereinafter, the "Waving Flag Design"), with the mark depicted as follows:



and

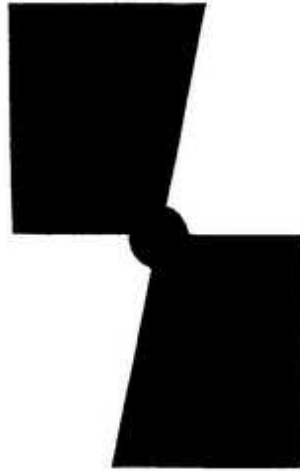
ANDALE! ENERGY DRINK (& Design) for "Energy drinks" in Class 32, Serial No. 85/334,836 (hereinafter, the "Andale! Energy Drink Mark"), depicted as follows:



Opposer filed two oppositions¹ alleging the marks therein are likely to cause confusion with its design mark of Reg. No. 2829269, which "covers" "Non-alcoholic beverages, namely, soft drinks,

¹ Proceeding Nos. 91-210 and 860, 91-204,861 are now consolidated. There is a pending Motion for Partial Judgment on the Pleadings (filed April 15, 2014) pertaining to a third, different mark of Application Ser. No. 85/646,359. Although this proceeding is currently suspended on account of the filing of the April 15, 2014 motion, the Board issued an order on April 21, 2014, directing Applicant to "serve responses to written discovery requests that opposer served on March 21, 2014, insofar as that discovery seeks information and documents with respect to the two applications that are not the subject of the motion for judgment on the pleadings, namely, application Serial No. 85334836 and Serial No. 85646316." The responses are due on April 25, 2014. Applicant has complied with the Board's order and has timely served its discovery responses.

sports drinks, energy drinks" in International Class 32 ("Opposer's Mark"), with the mark depicted as follows:



A simple comparison of the visual features of the marks shows that they are utterly dissimilar in appearance, sound, meaning, and commercial impression, which precludes a finding of likelihood of confusion. See *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563 (CCPA 1973). Even viewing all other DuPont factors in Opposer's favor—and Applicant concedes them for the purposes of this Motion²—the dissimilarities between the marks are so great as to avoid likelihood of confusion. Further, for the purposes of this Motion insofar as it relates to the Andale! Energy Drink Mark (Ser. No. 85/334,836), Applicant even concedes that the word portion ANDALE! is not the dominant portion of the mark.³ In addition, Applicant does not argue herein

² The Board should not find any genuine dispute of material fact relating to any of the other DuPont factors because Applicant has conceded them. As the other factors may be construed in Opposer's favor, there is no dispute as to these factors. The only issue raised in this Motion is the single factor of the similarity or dissimilarity of the marks.

³ On December 19, 2013, the Board denied Applicant's motion for summary judgment pertaining to the Andale! Energy Drink Mark (Ser. No. 85/334,836), finding a genuine dispute of material fact as to consumer perception of the word and design elements of the marks. Specifically, the Board found that "opposer has presented evidence that indicates that there is a genuine dispute regarding whether and how purchasers of energy drinks perceive the design elements of the marks." For the purposes of this Motion, Applicant now concedes that the word portion ANDALE! is not the dominant portion of the mark. In addition, Applicant does not herein argue that any particular portion of the marks is "dominant". Thus, there is no longer any genuine dispute of material fact regarding whether the word or design portion of the marks is dominant, and such prior dispute cannot now prevent the Board from determining the sole issue of the similarity or dissimilarity of the marks. Moreover, inasmuch as this is a motion for judgment on the

that any particular portion of the marks is "dominant". Given these concessions and the resulting absence of any genuine dispute of material fact, the Board may reach the conclusion that confusion is not likely based on a consideration of the dissimilarity of the marks alone. See *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result). Further, the marks are so dissimilar as to preclude a finding of false suggestion of a connection under Section 2(a). Accordingly, Applicant's Motion for Partial Judgment on the Pleadings should be granted, and the opposition should be dismissed with prejudice as to Ser. Nos. 85/646,316 and 85/334,836.

Legal Standard

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion, all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ2d 1048 (TTAB 1992). All reasonable

pleadings, neither of the parties can submit any evidence which may create a genuine dispute of material fact; nor can the Board consider any evidence presented on the previous motion for summary judgment which may have once created a genuine dispute of material fact. See, e.g., *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Unlike Applicant's prior motion for summary judgment, which required the consideration of evidence, the Board is now tasked with determining the issue of likelihood of confusion with respect to 85/334,836 on the pleadings, taken together with the concessions Applicant has made herein. The pleadings and Applicant's concessions herein do not raise any genuine dispute of material fact.

inferences from the pleadings are drawn in favor of the nonmoving party. *Id.* A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Id.*

This Motion is timely. "[T]o be timely, a motion for judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period, as originally set or as reset." TBMP § 504.01. Opposer's testimony period has not yet begun. The first testimony period is set to begin on May 20, 2014, which is nearly one month from now. Opposer has not even served its Pretrial Disclosures, which are due on May 5, 2014. Further, discovery is still ongoing (Applicant timely served its discovery responses today) and there is no indication that discovery will be complete before the opening of the first testimony period. For example, Opposer may file additional discovery motions prior to trial, which would delay the opening of the first testimony period.

Second, and importantly, the parties were in settlement negotiations for many months until Opposer's counsel, Martin R. Greenstein, broke off settlement discussions on March 26, 2014. Applicant was forced to undertake the burden and expense of filing its first motion for partial judgment on the pleadings as soon as it could—on April 15, 2014. The instant Motion followed only ten (10) days later. Inasmuch as both motions were filed prior to the opening of the first testimony period and Applicant had good reason to file them when it did—shortly after settlement negotiations failed at the end of the discovery period, this Motion is timely. Applicant now turns to the merits of the Motion.

The Marks Are Dissimilar in Appearance, Sound, Meaning, and Commercial Impression

The Lanham Act prohibits registration of a mark on the Principal Register that would create a likelihood of confusion. 15 U.S.C. § 1052(d). Whether a mark is likely to cause confusion under Section 2(d) is a question of law. *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1565, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987); *Monarch Marking Systems, Inc. v. Elan Systems, Inc.*, 39 U.S.P.Q.2d 1035 (TTAB 1996); *Blansett Parmacal Co. Inc. v. Carmic Laboratories, Inc.* 25 U.S.P.Q.2d 1473, 1476 (TTAB 1992); *Blue Cross and Blue Shield Ass'n v. Harvard Community Health Plan, Inc.*, 17 U.S.P.Q. 1075 (TTAB 1990).

"[O]ne DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (court affirms Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em Enterprises, Inc.*, supra (court affirms Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989)(court affirms Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES). See also *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 USPQ2d 1381 (TTAB 2005) (dissimilarity of the marks ONFOLIO and design and CARTAGIO dispositive); *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 USPQ2d 1227 (TTAB 1992) (dissimilarity between the marks APPROVAL PLUS and APPROVALFIRST dispositive).

Here, the marks are completely different in appearance, sound, meaning, and commercial impression, which precludes a finding of likelihood of confusion. See *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563 (CCPA 1973). Further, Applicant respectfully submits that it

has adequately met its burden in establishing the absence of any genuine issues of material fact. The circumstances here are similar to those in *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in that the single DuPont factor of the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion. For the purposes of this motion, the Board may even consider the other DuPont factors, such as the relationship between the goods and the alleged fame of Opposer's mark, in Opposer's favor. By Applicant's concession of these other factors, they are not in dispute. Even viewing all other DuPont factors in Opposer's favor, the dissimilarities of the marks is so great as to avoid likelihood of confusion.

1. Appearance

It is clear that Opposer's Mark and Applicant's Waving Flag Design of Ser. No. 85/646,316 are dissimilar in appearance. Applicant's Mark features a soccer player kicking ball and the word ANDALE! across a rectangular flag background with four planes of alternating shades, each separated by curved lines. Each plane has varying shades within to create the appearance of a three-dimensional, waving flag. There is no dispute that none of these features are present in Opposer's Mark. Because the marks do not share any of these features, the marks are not similar in appearance, and confusion is not likely as to Ser. No. 85/646,316.

It is also clear that Opposer's Mark and Applicant's Andale! Energy Drink Mark are dissimilar in appearance. Applicant's Mark features a soccer player kicking a ball and the word ANDALE!, whereas the Opposer's mark does not. Applicant's mark also features rectangles with the aforementioned ANDALE! and soccer player kicking a ball in the center, whereas Opposer's Mark consists only of trapezoids of alternating shades and a small circle in the center, with a slant

across the diagonal of the mark. There is no dispute that none of the aforementioned features of Applicant's mark are present in Opposer's Mark. Further, Applicant does not assert that any particular portion of its mark is dominant. Regardless of which portion the Board considers "dominant" (and Applicant does not ask the Board to make any particular finding) the fundamental rule is that the marks must be compared in their entirety. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974) (emphasis added). When considered in their entirety, the marks are not similar in appearance, and confusion is not likely as to Ser. No. 85/334,836.

2. Sound

The marks are completely different in sound. There is no dispute that Opposer's Mark is a design mark and does not have a sound. Both of Applicant's marks of Ser. Nos. 85/646,316 and 85/334,836 contain the word element ANDALE!. Applicant's marks thus have a sound which is not shared by Opposer's Mark. Accordingly, the marks are dissimilar in sound.

3. Meaning

The marks are completely different in meaning and connotation. Both of Applicant's marks of Ser. Nos. 85/646,316 and 85/334,836 contain the word ANDALE!. There is no dispute that Opposer's Mark does not contain this word, and therefore, Opposer's Mark cannot convey a meaning or connotation similar to "ANDALE!". Nor is there any dispute that Opposer's Mark does not contain a soccer player or a ball. Accordingly, the marks are dissimilar in meaning.

4. Commercial Impression

Applicant's Waving Flag Design Mark (Ser. No. 85/646,316) creates the impression of a soccer player kicking a ball and the call to action "ANDALE!" on top of four curved planes with varying shades to imitate a three-dimensional, waving flag. Opposer's Mark does not contain any

of these elements and does not create a similar commercial impression. Applicant's Andale! Energy Drink Mark (Ser. No. 85/334,836) creates the commercial impression of ANDALE! energy drink with a soccer player kicking a ball on top of four rectangles of alternating shades resembling a "checkered" background. Opposer's mark is solely a design consisting of trapezoids and a circle with a diagonal across the center. Applicant's and Opposer's Marks do not share any features and are thus dissimilar in commercial impression.

Overall, the marks are dissimilar in appearance, sound, meaning, and create dissimilar commercial impressions. See *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (court affirms Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em Enterprises, Inc.*, supra (court affirms Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (court affirms Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES). See also *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 USPQ2d 1381 (TTAB 2005) (dissimilarity of the marks ONFOLIO and design and CARTAGIO dispositive) and *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 USPQ2d 1227 (TTAB 1992) (dissimilarity between the marks APPROVAL PLUS and APPROVALFIRST dispositive).

In view of the clear differences between the marks, there is no likelihood of confusion as a matter of law. The Board may reach this conclusion solely by comparing the marks in their entireties for dissimilarities in appearance, sound, meaning, and commercial impression. It is beyond dispute that Applicant's and Opposer's marks contain different features. The differences are so great as to preclude a likelihood of confusion under Section 2(d). The differences between

the marks are also so great as to preclude a finding of false suggestion of a connection under Section 2(a). Accordingly, the Notice of Opposition should be dismissed as to Ser. Nos. 85/646,316 and 85/334,836.

Conclusion

Based on the foregoing, Applicant's Motion for Partial Judgment on the Pleadings should be granted, and the opposition should be dismissed with prejudice as to Ser. Nos. 85/646,316 and 85/334,836.

Respectfully submitted,

Date: April 25, 2014

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PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS** has been served on Martin R. Greenstein, counsel for Opposer, on April 25, 2014 via First Class U.S. Mail, postage prepaid to:

Martin R. Greenstein
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San Jose, CA 95124-5273

/Paulo A. de Almeida
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